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**MAILED**

**MAR 16 2009**

**OFFICE OF PETITIONS**

In re Application  
Heidrun Engler et al.  
Application No. 10/055,863  
Filed: January 22, 2002  
Attorney Docket No. 016930-  
000816US

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:  
: DECISION ON APPLICATION  
: FOR PATENT TERM ADJUSTMENT  
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This is in response to the REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT DETERMINATION UNDER 37 C.F.R. § 1.705(b) filed December 22, 2008. Applicant requests that the determination of patent term adjustment be increased by 327 days to a total of three hundred fifty-nine (359) days. Applicant requests this correction in part on the basis that the Office will take in excess of three years to issue this patent and in light of the recent court decision in *Wyeth v. Dudas*, No. 07-1492 (D.D.C. September 30, 2008).

To the extent that the instant application for patent term adjustment requests reconsideration of the patent term adjustment as it relates to the Office's failure to issue the patent within 3 years of the filing date, a decision is being held in abeyance until after the actual patent date. Knowledge of the actual date the patent issues is required to calculate the amount, if any, of additional patent term patentee is entitled to for Office failure to issue the patent within 3 years. See § 1.703(b). (This is true even in this instance where a request for continued examination (RCE) was filed. The computer will not undertake the § 1.703(b) calculation until the actual date of issuance of the patent has been determined. Accordingly, it is still too soon to make a determination as to the correctness of any period of adjustment that will or will not be entered pursuant to § 1.703(b)).

Applicant is given TWO (2) MONTHS from the issue date of the patent to file a written request for reconsideration of the patent term adjustment for Office failure to issue the patent within 3 years. A copy of this decision should accompany the request. Applicant may seek such consideration without payment of an additional fee. However, as to all other bases for seeking reconsideration of the patent term adjustment indicated in the patent, all requirements of § 1.705(d) must be met. Requests for reconsideration on other bases must be timely filed and must include payment of the required fee.

Rather than file the request for reconsideration of Patent Term Adjustment at the time of the mailing of the notice of allowance, applicant is advised that they may wait until the time of the issuance of the patent and file a request for reconsideration of the patent term pursuant to 37 CFR 1.705(d). The USPTO notes that it does not calculate the amount of time earned pursuant to 37 CFR 1.702(b) until the time of the issuance of the patent and accordingly, the Office will consider any request for reconsideration of the patent term adjustment due to an error in the calculation of 37 CFR 1.702(b) to be timely if the request for reconsideration is filed within two months of the issuance of the patent.

It is acknowledged that applicant is correct that any period of adjustment will be entered in light of 35 U.S.C. 154(B) GUARANTEE OF NO MORE THAN 3-YEAR APPLICATION PENDENCY, which provides that:

Subject to the limitations under paragraph (2), if the issue of an original patent is delayed due to the failure of the United States Patent and Trademark Office to issue a patent within 3 years after the actual filing date of the application in the United States, not including —

(i) any time consumed by continued examination of the application requested by the applicant under section 132(b);

It is noted that a Request for Continued Examination (RCE) was filed in this application on August 13, 2008.

To the extent that applicant otherwise requests correction of the patent term adjustment at the time of the mailing of the notice of allowance, the application for patent term adjustment is GRANTED to the extent indicated herein.

The Office has updated the PAIR screen to reflect that the correct Patent Term Adjustment (PTA) determination at the time of the mailing of the Notice of Allowance is zero (0) days. A copy of the updated PAIR screen, showing the correct determination, is enclosed.

On September 29, 2008, the Office mailed the Determination of Patent Term Adjustment under 35 U.S.C. 154(b) in the above-identified application. The Notice stated that the patent term adjustment to date is 32 days. The instant application for patent term adjustment was timely filed<sup>1</sup> on or before payment of the issue fee. Applicants dispute the entry of a period of reduction of 16 days for applicant's response to the non-Final Office Action mailed November 21, 2007. Applicants argue that the

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<sup>1</sup> PALM records indicate that the issue fee payment was filed on December 22, 2008.

response was filed February 29, 2008 and calculate Applicant delay at 8 days, but the Office incorrectly calculates 16 days of applicants' delay. Applicants assert that the correct number of days of delay is 8 in accordance with 35 USC 154(b)(2)(C)(ii) and 37 CFR 1.704(b). Eight (8) days are at issue.

The reduction of 16 days has been found to be incorrect. A review of the application file reveals that, as stated by applicants, their response to the non-Final Office action mailed November 21, 2007, is of record in the application with a date of receipt by the Office of February 29, 2008. Thus, the Office should not assessed applicants a delay of sixteen (16) days. The period of reduction of 16 days is being removed and a period of reduction of 8 days is being entered.

A review of the record reveals additional bases for entry of periods of reduction for applicant delay. Specifically, 37 CFR 1.704(c) provides, in pertinent part, that:

Circumstances that constitute a failure of the applicant to engage in reasonable efforts to conclude processing or examination of an application also include the following circumstances, which will result in the following reduction of the period of adjustment set forth in § 1.703 to the extent that the periods are not overlapping:

(10) Submission of an amendment under § 1.312 or other paper after a notice of allowance has been given or mailed, in which case the period of adjustment set forth in § 1.703 shall be reduced by the lesser of:

(i) The number of days, if any, beginning on the date the amendment under § 1.312 or other paper was filed and ending on the mailing date of the Office action or notice in response to the amendment under § 1.312 or such other paper; or

(ii) Four months; ...

In this instance, after the mailing of a Notice of Allowance on April 24, 2008, on July 22, 2008, applicants filed an amendment under 1.312. On September 29, 2008, the examiner mailed a Notice of Allowance in response to the amendment. Accordingly, pursuant to 37 CFR 1.704(c)(10), a period of reduction for applicant delay of 70 days, counting the number of days beginning on July 22, 2008 and ending on September 29, 2008, should have been entered.

Furthermore, on August 13, 2008, applicants filed a Petition to Withdraw from Issue, a Request for Continued Examination and an Information Disclosure Statement. A new

Notice of Allowance was mailed in response on September 29, 2008. The IDS did not include a §1.704(d) statement. These papers were filed after the mailing of the Notice of Allowance on April 24, 2008 and payment of the Issue Fee on July 23, 2008.

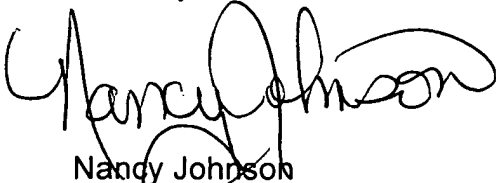
Accordingly, pursuant to 37 CFR 1.704(c)(10), a period of reduction for applicant delay is warranted. However, the period begins August 13, 2008 and ends September 29, 2008. As this period totally overlaps with the 70 day reduction discussed above, no further reduction pursuant to 37 CFR 1.704(c)(10) will be entered.

In view thereof, the patent term adjustment at the time of the mailing of the notice of allowance is (0) days.

The Office acknowledges submission of the \$200.00 fee set forth in 37 CFR 1.18(e). No additional fees are required.

The application is being forwarded to the Office of Data Management for issuance of the patent. The patent term adjustment indicated on the patent (as shown on the Issue Notification mailed about three weeks prior to patent issuance) will include any additional adjustment accrued both for Office delay in issuing the patent more than four months after payment of the issue fee and satisfaction of all outstanding requirements, and for the Office taking in excess of three years to issue the patent (to the extent that the three-year period does not overlap with periods already accorded).

Telephone inquiries specific to this decision should be directed to Senior Petitions Attorney Patricia Faison-Ball at (571) 272-3212.

A handwritten signature in black ink, appearing to read "Nancy Johnson", with a large, stylized loop at the end.

Nancy Johnson  
Senior Petitions Attorney  
Office of Petitions

Enclosure: Copy of Revised PALM Screen.

# PALM INTRANET

Time: 15:22:03

## PTA Calculations for Application: 10/055863

Application Filing Date:	01/22/2002	PTO Delay (PTO):	216
Issue Date of Patent:		Three Years:	0
Pre-Issue Petitions:	0	Applicant Delay (APPL):	184
Post-Issue Petitions:	0	Total PTA (days):	0
PTO Delay Adjustment:	-62		

## File Contents History

Number	Date	Contents Description	PTO	APPL	START
157	03/12/2009	ADJUSTMENT OF PTA CALCULATION BY PTO		70	
156	02/24/2009	ADJUSTMENT OF PTA CALCULATION BY PTO	8		
147	09/29/2008	MAIL NOTICE OF ALLOWANCE			
146	09/25/2008	ISSUE REVISION COMPLETED			
145	09/25/2008	DOCUMENT VERIFICATION			
144	09/25/2008	NOTICE OF ALLOWANCE DATA VERIFICATION COMPLETED			
143	09/25/2008	NOTICE OF ALLOWABILITY			
140	09/18/2008	WORKFLOW - QUERY REQUEST - FINISH			
139	08/13/2008	REFERENCE CAPTURE ON IDS			
138	08/13/2008	ELECTRONIC INFORMATION DISCLOSURE STATEMENT			
137	09/09/2008	DATE FORWARDED TO EXAMINER			
136	08/13/2008	REQUEST FOR CONTINUED EXAMINATION (RCE)			
135	09/09/2008	DISPOSAL FOR A RCE/CPA/129 (EXPRESS ABANDONMENT IF CPA)			
134	08/21/2008	MAIL MISCELLANEOUS COMMUNICATION TO APPLICANT			
133	08/18/2008	MISCELLANEOUS COMMUNICATION TO APPLICANT - NO ACTION COUNT			
132	08/13/2008	INFORMATION DISCLOSURE STATEMENT CONSIDERED			
131	08/13/2008	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
130	08/15/2008	MAIL-RECORD PETITION DECISION OF GRANTED TO WITHDRAW FROM ISSUE			
129	08/15/2008	RECORD PETITION DECISION OF GRANTED TO WITHDRAW FROM ISSUE			

128	08/13/2008	PETITION ENTERED			
127	08/13/2008	WORKFLOW - REQUEST FOR RCE - BEGIN			
126	07/23/2008	ISSUE FEE PAYMENT VERIFIED			
125	07/23/2008	ISSUE FEE PAYMENT RECEIVED			
124	07/22/2008	AMENDMENT AFTER NOTICE OF ALLOWANCE (RULE 312)			
123	06/20/2008	PUBS CASE REMAND TO TC			
122	06/24/2008	WORKFLOW - QUERY REQUEST - BEGIN			
121	04/28/2008	EXPORT TO INITIAL DATA CAPTURE			
120	04/24/2008	MAIL NOTICE OF ALLOWANCE			
120	04/24/2008	MAIL NOTICE OF ALLOWANCE			
119	04/23/2008	ISSUE REVISION COMPLETED			
119	04/23/2008	ISSUE REVISION COMPLETED			
118	04/23/2008	DOCUMENT VERIFICATION			
118	04/23/2008	DOCUMENT VERIFICATION			
117	04/23/2008	NOTICE OF ALLOWANCE DATA VERIFICATION COMPLETED			
117	04/23/2008	NOTICE OF ALLOWANCE DATA VERIFICATION COMPLETED			
116	04/23/2008	CASE DOCKETED TO EXAMINER IN GAU			
116	04/23/2008	CASE DOCKETED TO EXAMINER IN GAU			
115	04/23/2008	NOTICE OF ALLOWABILITY			
115	04/23/2008	NOTICE OF ALLOWABILITY			
111	02/29/2008	INFORMATION DISCLOSURE STATEMENT CONSIDERED			
111	02/29/2008	INFORMATION DISCLOSURE STATEMENT CONSIDERED			
110	02/29/2008	INFORMATION DISCLOSURE STATEMENT (IDS) FILED		0	108
110	02/29/2008	INFORMATION DISCLOSURE STATEMENT (IDS) FILED		0	108
109	03/21/2008	DATE FORWARDED TO EXAMINER			
109	03/21/2008	DATE FORWARDED TO EXAMINER			
108	02/29/2008	RESPONSE AFTER NON-FINAL ACTION		8	105
108	02/29/2008	RESPONSE AFTER NON-FINAL ACTION		8	105
107	02/29/2008	REQUEST FOR EXTENSION OF TIME - GRANTED			
107	02/29/2008	REQUEST FOR EXTENSION OF TIME - GRANTED			
		INFORMATION DISCLOSURE STATEMENT (IDS)			

106	02/29/2008	FILED			
106	02/29/2008	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
105	11/21/2007	MAIL NON-FINAL REJECTION			
105	11/21/2007	MAIL NON-FINAL REJECTION			
104	11/19/2007	NON-FINAL REJECTION			
104	11/19/2007	NON-FINAL REJECTION			
101	10/21/2007	DATE FORWARDED TO EXAMINER			
101	10/21/2007	DATE FORWARDED TO EXAMINER			
100	10/12/2007	RESPONSE AFTER NON-FINAL ACTION			
100	10/12/2007	RESPONSE AFTER NON-FINAL ACTION			
99	09/10/2007	MAIL NON-FINAL REJECTION			
99	09/10/2007	MAIL NON-FINAL REJECTION			
98	09/04/2007	NON-FINAL REJECTION			
98	09/04/2007	NON-FINAL REJECTION			
97	07/26/2007	INFORMATION DISCLOSURE STATEMENT CONSIDERED			
97	07/26/2007	INFORMATION DISCLOSURE STATEMENT CONSIDERED			
96	07/26/2007	REFERENCE CAPTURE ON IDS			
95	07/26/2007	INFORMATION DISCLOSURE STATEMENT (IDS) FILED		3	92
94	07/26/2007	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
93	07/25/2007	DATE FORWARDED TO EXAMINER			
92	07/23/2007	RESPONSE AFTER NON-FINAL ACTION			
91	04/23/2007	MAIL NON-FINAL REJECTION			
90	04/19/2007	NON-FINAL REJECTION			
89	04/18/2007	WORKFLOW - QUERY REQUEST - FINISH			
88	04/02/2007	INFORMATION DISCLOSURE STATEMENT CONSIDERED			
87	04/02/2007	REFERENCE CAPTURE ON IDS			
86.7	04/02/2007	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
86	04/02/2007	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
85	03/11/2007	INFORMATION DISCLOSURE STATEMENT CONSIDERED			
84	03/11/2007	REFERENCE CAPTURE ON IDS			
		INFORMATION DISCLOSURE STATEMENT (IDS)			

83.7	03/12/2007	FILED			
83	03/12/2007	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
82	03/16/2007	DATE FORWARDED TO EXAMINER			
81	03/11/2007	REQUEST FOR CONTINUED EXAMINATION (RCE)			
80	03/16/2007	DISPOSAL FOR A RCE/CPA/129 (EXPRESS ABANDONMENT IF CPA)			
79	03/12/2007	WORKFLOW - REQUEST FOR RCE - BEGIN			
78	02/14/2007	MAIL MISCELLANEOUS COMMUNICATION TO APPLICANT			
77	02/12/2007	MISCELLANEOUS COMMUNICATION TO APPLICANT - NO ACTION COUNT			
76	01/23/2007	PUBS CASE REMAND TO TC			
75	01/31/2007	WORKFLOW - QUERY REQUEST - BEGIN			
74	01/25/2007	RECEIPT INTO PUBS			
73	12/27/2006	RECEIPT INTO PUBS			
72	12/21/2006	RECEIPT INTO PUBS			
71	12/15/2006	EXPORT TO INITIAL DATA CAPTURE			
70	12/12/2006	MAIL NOTICE OF ALLOWANCE			
69	12/04/2006	ISSUE REVISION COMPLETED			
68	12/04/2006	NOTICE OF ALLOWANCE DATA VERIFICATION COMPLETED			
67	12/04/2006	CASE DOCKETED TO EXAMINER IN GAU			
66	11/27/2006	NOTICE OF ALLOWABILITY			
65	10/27/2006	INFORMATION DISCLOSURE STATEMENT CONSIDERED			
64	11/14/2006	DATE FORWARDED TO EXAMINER			
63	10/27/2006	RESPONSE AFTER NON-FINAL ACTION		34	59
62	10/27/2006	REFERENCE CAPTURE ON IDS			
61.7	10/27/2006	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
61	10/27/2006	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
60	10/27/2006	REQUEST FOR EXTENSION OF TIME - GRANTED			
59	06/23/2006	MAIL NON-FINAL REJECTION			
58	06/21/2006	NON-FINAL REJECTION			
57	06/02/2006	DATE FORWARDED TO EXAMINER			
56	04/10/2006	RCE- AF PROCESSED			



55	06/02/2006	DATE FORWARDED TO EXAMINER			
54	06/01/2006	REQUEST FOR CONTINUED EXAMINATION (RCE)			
53	06/02/2006	DISPOSAL FOR A RCE/CPA/129 (EXPRESS ABANDONMENT IF CPA)			
52	06/01/2006	REQUEST FOR EXTENSION OF TIME - GRANTED			
51	04/27/2006	MAIL ADVISORY ACTION (PTOL - 303)			
50	04/25/2006	ADVISORY ACTION (PTOL-303)			
49	04/12/2006	PARALEGAL TD ACCEPTED			
48	04/11/2006	DATE FORWARDED TO EXAMINER			
47	04/10/2006	AMENDMENT/ARGUMENT AFTER NOTICE OF APPEAL			
46	12/08/2005	NOTICE OF APPEAL FILED		64	44
45	12/08/2005	REQUEST FOR EXTENSION OF TIME - GRANTED			
44	07/05/2005	MAIL FINAL REJECTION (PTOL - 326)			
43	06/30/2005	FINAL REJECTION			
42	05/25/2005	DATE FORWARDED TO EXAMINER			
41	05/16/2005	RESPONSE AFTER NON-FINAL ACTION		64	39
40	05/16/2005	REQUEST FOR EXTENSION OF TIME - GRANTED			
39	12/13/2004	MAIL NON-FINAL REJECTION			
38	12/10/2004	NON-FINAL REJECTION			
37	12/10/2004	PARALEGAL TD ACCEPTED			
36	12/10/2004	PARALEGAL TD ACCEPTED			
35	12/07/2004	DATE FORWARDED TO EXAMINER			
34	11/29/2004	AMENDMENT AFTER FINAL REJECTION			
33	11/29/2004	MISCELLANEOUS INCOMING LETTER			
32	11/29/2004	TERMINAL DISCLAIMER FEE PAID			
31	11/29/2004	WORKFLOW INCOMING AMENDMENT IFW			
30	10/01/2004	MAIL FINAL REJECTION (PTOL - 326)			
29	09/30/2004	FINAL REJECTION			
28	09/09/2004	DATE FORWARDED TO EXAMINER			
27	08/30/2004	RESPONSE AFTER NON-FINAL ACTION		3	24
26.7	08/30/2004	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
26	08/30/2004	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			

25	08/30/2004	WORKFLOW INCOMING AMENDMENT IFW			
24	05/27/2004	MAIL NON-FINAL REJECTION			
23	05/25/2004	NON-FINAL REJECTION			
22	05/19/2004	DATE FORWARDED TO EXAMINER			
21	05/06/2004	RESPONSE TO ELECTION / RESTRICTION FILED			
20	05/06/2004	REQUEST FOR EXTENSION OF TIME - GRANTED			
19	05/06/2004	WORKFLOW INCOMING AMENDMENT IFW			
18	02/13/2004	MAIL RESTRICTION REQUIREMENT			
17	02/11/2004	REQUIREMENT FOR RESTRICTION / ELECTION			
16	02/01/2004	CASE DOCKETED TO EXAMINER IN GAU			
15	12/13/2003	DATE FORWARDED TO EXAMINER			
14	11/26/2003	RESPONSE TO ELECTION / RESTRICTION FILED			
13	11/26/2003	REQUEST FOR EXTENSION OF TIME - GRANTED			
12	10/24/2003	MAIL RESTRICTION REQUIREMENT	216		-1
11	10/22/2003	REQUIREMENT FOR RESTRICTION / ELECTION			
10	10/02/2003	IFW TSS PROCESSING BY TECH CENTER COMPLETE			
9	05/14/2002	X-PRE-LEGAL COMPLETE AMENDED CASE			
8	04/29/2002	PRELIMINARY AMENDMENT			
7	04/09/2002	X-PRE-LEGAL COMPLETE AMENDED CASE			
6	03/29/2002	PRELIMINARY AMENDMENT			
5	03/24/2002	CASE DOCKETED TO EXAMINER IN GAU			
4	03/05/2002	APPLICATION DISPATCHED FROM OIPE			
3	03/04/2002	APPLICATION IS NOW COMPLETE			
2	02/14/2002	IFW SCAN & PACR AUTO SECURITY REVIEW			
1	01/22/2002	INITIAL EXAM TEAM NN			

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#### **EXPLANATION OF PTA CALCULATION**

#### **EXPLANATION OF PTE CALCULATION**

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